

### **REMARKS**

Applicants traverse the rejections and add claims 33-37. Support for these claims can be found at least in Figures 3–5, and paragraph 0027. No new matter is added.

As a preliminary matter, Applicants request withdrawal of the finality of the pending action. According to MPEP 706.07(a), a “second or any subsequent action on the merits in any application...should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.” Claims 1, 2, 4–6, 9, 22, and 24–28 are rejected over a reference not previously of record, i.e., Junge. In addition, none of the claims in the application were amended in Applicants’ prior response to recite subject matter that would not reasonably have been expected to be claimed. In fact, the only amendment to the claims in Applicants’ last response amended independent claim 1 to add subject matter previously recited in claim 21. Thus, the finality of the Action is premature, and Applicants request the finality of the Action be withdrawn.

Independent claim 1 is rejected over Collum in view of Buckley and Junge. None of the cited references teach or suggest a encasing material formed around a first helical spring, as recited in claim 1. As conceded in the prior Action, Collum fails to describe encasing material formed around a helical spring. Buckley also fails to describe the use of an encasing material. The Action asserts that elements B and d described in Junge satisfy this element of independent claim 1. Applicants disagree. Element B refers to a padded mattress top and element d refers to ticking that closes the bottom and sides of the spring-sections, neither of which constitute an encasing material formed around a first helical spring.

In addition, to make a prima facie case of obviousness, an examiner must provide objective evidence of a suggestion or motivation in the art to combine the references. MPEP § 2142. As further recited in MPEP § 2145, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.” See also, *In re Fitch* 972 F.2d 1260, 1265 (Fed.Cir.1992) (“the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of

the references”)). Moreover, the Board of Patent Appeals has noted on a number of occasions, including in *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (1992), for evidence of a motivation to combine references to be sufficient to form the basis of an obviousness rejection, the evidence would have to “impel one skilled in the art to do what the patent applicant has done.” As the Board and the courts have repeatedly held, such evidence is essential to avoid the impermissible use of hindsight, using “that which only the inventor taught [] against the teacher.” See *In re Dembiczak*, 175 F.3d 994 (quoting *W.L. Gore & Assoc., Inc v. Garlock, Inc.* 721 F.2d 1540, 1553).

To justify the combination of the references, the Action merely states that one skilled in the art would use the asserted encasing material of Junge to “provide a simple means for protecting each helical spring and for imparting enhanced user comfort.” This statement fails to include any objective evidence that a suggestion or motivation to combine the references existed at the time of the invention of the subject matter by the Applicant. Moreover, Junge does not teach or suggest the individual protection of each helical spring, as asserted in the Action. Instead, Junge describes closing entire spring-sections, A and A<sup>2</sup>, which in Fig. 2 each include 40 springs. Thus, one must assume that the Action’s suggested combination is motivated by impermissible hindsight.

For these reasons, Applicants request reconsideration and withdrawal of the §103 rejection of independent claim 1. Claims 2–20 and 22–32 depend from claim 1, directly or indirectly, and add further limitations, thereto. Thus, Applicants request reconsideration and withdrawal of the §103 rejections of these claims, too.

In addition, new claims 33–37 depend from independent claim 1 and also recite additional distinguishing subject matter. For example, new claim 33 recites that the first helical spring is a pocketed spring. As asserted in the prior action, Collum would be inoperable in combination with a mattress that included pocketed springs as such springs would be unable to be attached to the wire frame Collum discloses. Claim 34 recites that the encasing material comprises foam. Claim 35 depends on claim 34 and recites that the encasing material is formed above and below the first helical spring. Claim 36 recites that the encasing material fits between at least two of the active coils of the first helical spring. Claim 37 recites that the encasing material fits between an inactive coil and an active coil. None of the cited references teach or

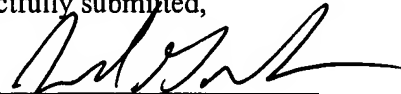
suggest the subject matter of these new claims. Thus, Applicants request allowance of claims 33-37.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. SMCY-P03-098 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

Edward A. Gordon

Registration No.: 54,130  
ROPES & GRAY LLP  
One International Place  
Boston, Massachusetts 02110-2624  
(617) 951-7000  
(617) 951-7050 (Fax)  
Attorneys/Agents For Applicant